

REMARKS

Claims 1 to 21 are pending in this application.¹ Of these, claims 1 and 4 are independent. Favorable reconsideration and further examination are respectfully requested.

The Office Action requires election of one of the alleged species I to VI of Figs. 5 to 10, respectively. Applicants hereby elect the species of Fig. 6, and agree with the Examiner that claim 1 is generic. Claims 1 to 6, 7 to 16, and 18 to 20 are believed to read on the elected species. This election is made with traverse for at least the following reasons.

This application is a PCT national stage application. Accordingly, pursuant to MPEP §1850, the USPTO is required to follow PCT rules regarding unity of invention. In particular, the MPEP states:

Therefore, when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111. No change was made in restriction practice in United States national applications filed under 35 U.S.C. 111 outside the PCT. (emphasis added)

Thus, to reiterate, U.S. restriction rules do not apply to this case. PCT rules apply.

Applicants submit that there is unity of invention for this application under PCT Rules 13.1 and 13.2. In this regard, PCT Rule 13.2 states

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

¹ The Examiner is urged to independently confirm this recitation of the pending claims.

As stated in the rule, a special technical feature means “technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art”.

PCT rules regarding unity of invention are not understood to provide for requirements to elect species. In fact, PCT Rule 13.4 states

Subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention. (emphasis added)

Thus, if there is unity of invention pursuant to PCT Rule 13.1, which Applicants contend there is in this case, then the application may contain dependent claims “even where the features of any dependent claim could be considered as constituting in themselves an invention”.

In this regard, Figs. 5 to 10 each depict resonators having the construction of claim 1. Accordingly, each of Figs. 5 to 10 shows an embodiment having the same inventive concept, i.e., special technical feature. Therefore, each of Figs. 5 to 10 meets the unity of invention rules under the PCT. Since there is unity of invention, according to PCT Rule 13.4, the application may include dependent claims directed to various features of the invention, which “could be considered as constituting in themselves an invention” without being subject to restriction.

For at least the foregoing reasons, Applicants respectfully request withdrawal of the election of species requirements.

Applicants' undersigned attorney can be reached at the address shown below. All telephone calls should be directed to the undersigned at 617-521-7896.


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Please apply any fees or credits due in this case, which are not already covered by check,
to Deposit Account 06-1050 referencing Attorney Docket No. 14219-078US1.

Respectfully submitted,

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